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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,500	02/21/2001	Guillermo Lao	111325-40	6754
22204	7590	08/11/2004	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			RHODE JR, ROBERT E	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/788,500

Applicant(s)

LAO ET AL.0

Examiner

Rob Rhode

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 5, 7, 9 - 11, 13 - 103, 105, 107 - 109 and 111 - 146 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 - 5, 7, 9 - 11, 13 - 103, 105, 107 - 109 and 111 - 146 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/24/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Applicant amendment of 6-24-04 amended claims 1, 7, 9 – 11, 13, 15 – 18, 21, 28 – 31, 34, 40, 42 – 45, 47, 70, 82 – 84, 87, 91 – 93, 99, 107 – 109, 119, 126 – 128, 136, 138 – 141 and added new claims 143 - 146 and canceled claims 6, 8, 12, 104, 106 and 110 as well as traversed rejections of Claims 1 - 142.

Currently, claims 1 – 5, 7, 9 – 11, 13 – 103, 105, 107 – 109 and 111 - 146 are pending.

Drawings

It is noted that the applicant did state corrected drawings were included in the amendment. However, the amendment did not contain these corrected drawings. In that regard, the drawings filed on 2/21/2001 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftperson's Patent Drawing Review," PTO-948. In order to avoid abandonment of this application, correction is required in reply to the Office action. The correction will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 5, 7, 9 – 11, 13 – 103, 105, 107 – 109 and 111 - 146 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spagna (US 6,587,837 B1) in view of Ginter (US 6,253,193).

Regarding claim 1 and related claims 47, 93, 99 (Amended) and claim 143 (New), Spagna teaches a method and system for automatically publishing content, comprising: Identifying content and metadata for the content through a user computer system, the metadata being based on a user profile and including a content identifier (see at least Col 10, lines 56 – 65 and Col 15, lines 27 – 31 and Col 80, lines 29 - 31); associating a usage rights template and a publishing profile with the content, the publishing profile including a publisher identifier (see at least 27, lines 61 – 67 and Col 46, lines 26 – 67); storing the content to at least one of an identified content repository and media defined by the publishing profile (see at least Col 20, lines 27 – 31 and Figures 1D and 14);

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validating and registering the content, the metadata, a usage rights specification defined by the usage rights template and the publishing profile by a registrar computer system (see at least Col 46, lines 26 – 67 and Figures 4 and 6);

notifying distributor computer systems of the newly available content, the publisher identifier and the content identifier (see at least Col 71, lines 33 – 35);

in response to a request indicating the content identifier and the publishing identifier, transmitting the metadata and the usage rights specification to a distributor computer system (see at least Col 13, lines 1 – 65); and

automatically generating an item in the catalog of the distributor computer system based on the metadata and the usage rights specification to thereby make the content available for selection by consumers (see at least Col 75, lines 13 – 24 and Col 82, lines 11 – 34).

While Spagna does disclose identification information relative to a user, the reference does not specifically disclose and teach a user profile.

On the other hand, Ginter in the same area of online publishing of content discloses and teaches a user profile (see at least Col 25, lines 31 – 35 and Col 286, line 14). Please note Ginter does not specifically disclose a user profile. However, Ginter does disclose user identification as well as account profile, which meets the examples cited for user profile in the applicant's specification. Thereby, it would have been obvious to one of

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ordinary skill in the art to have extended the method and system of Ginter with a user profile.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the method and system of Spagna with the method and system of Ginter to have enabled a method and system for automatically publishing content, comprising: identifying content and metadata for the content through a user computer system, the metadata being based on a user profile and including a content identifier; associating a usage rights template and a publishing profile with the content, the publishing profile including a publisher identifier; storing the content to at least one of an identified content repository and media defined by the publishing profile; validating and registering the content, the metadata, a usage rights specification defined by the usage rights template and the publishing profile by a registrar computer system; notifying distributor computer systems of the newly available content, the publisher identifier and the content identifier; in response to a request indicating the content identifier and the publishing identifier, transmitting the metadata and the usage rights specification to a distributor computer system; and automatically generating an item in the catalog of the distributor computer system based on the metadata and the usage rights specification to thereby make the content available for selection by consumers – in order to have a method and system for content publishing, which includes rights management as well as user profiles. Spagna discloses a method and system for automatically publishing content, comprising: identifying content and metadata for the content through a user

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computer system, the metadata being based on a user profile and including a content identifier; associating a usage rights template and a publishing profile with the content, the publishing profile including a publisher identifier; storing the content to at least one of an identified content repository and media defined by the publishing profile; validating and registering the content, the metadata, a usage rights specification defined by the usage rights template and the publishing profile by a registrar computer system; notifying distributor computer systems of the newly available content, the publisher identifier and the content identifier; in response to a request indicating the content identifier and the publishing identifier, transmitting the metadata and the usage rights specification to a distributor computer system ; and automatically generating an item in the catalog of the distributor computer system based on the metadata and the usage rights specification to thereby make the content available for selection by consumers (Abstract, Col 15, lines 44 – 51 and Figures 1 – 10). Ginter discloses a method and system for publishing content with a user profile (see at least Col 25, lines 31 – 35 and Col 286, line 14). Therefore, one of ordinary skill in the art would have been motivated to extend the method and system of Spagna with a method and system for publishing content with a user profile. In this manner, the method and system will have all the necessary ordering as well as publishing capabilities to deliver content online to a consumer – who has the appropriate user profile. With this, the content publishers and distributors can be assured that they receive compensation for the content as well as having a check on limiting of content piracy.

Regarding claim 2 and related claims 49 and 100, Spagna teaches a method, wherein the metadata includes data describing and identifying the content (Col 12, lines 41 – 43) and (3 and related claims 50 and 101), wherein the metadata includes at least one of a content identifier, a title, an author's name, a publisher's name, a publication date, an image and a description of the content (Col 60, lines 60 – 67).

Regarding claim 4 and related claims 51, 102 and 144, Spagna teaches a method, wherein the content identifier is at least one of an International Standard Book Number (ISBN), a Digital Object Identifier (DOI), a Uniform Resource Identifier (URI), and a Library of Congress Control Number (LCCN)[Col 20, lines 7 – 8].

Regarding claim 5 and related claims 57 and 103, Spagna teaches a method, wherein the rights specification includes at least one of the rights to print, view, play, extract, and export (Col 12, lines 53 – 56 and Col 21, line 30).

Regarding claim 7 and related claim 105, Spagna teaches a method, wherein the step of generating the metadata comprises receiving information from the user (Col 12, lines 52 – 56).

Regarding claim 9 and related Claim 56 and related claims 52 and 107, Claim 10 and related claims 53 and 108 and Claim 11 and related claims 54 and 109, the recitations, “wherein the step of generating the metadata is based upon a user profile”, “wherein the

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step of generating the metadata is based upon default metadata”, “wherein the step of generating the metadata is based upon at least one inference rule” and “wherein the step of generating the metadata is based upon an analysis of the selected content”, such recitations are given little patentable weight because they impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other “generating” already disclosed by Spagna.

Regarding claim 13 and related claims 65 and 111, Spagna teaches a method, wherein the rights specification is created based upon a rights template (Col 22, lines 49 – 59).

Regarding claim 14 and related claims 64 and 112, Spagna teaches a method, wherein the rights template includes at least one usage right and a condition upon which the usage right is contingent (Col 3, lines 63 – 67 and Col 4, lines 26 – 30).

Regarding Claim 15 related claims 60, 67 and 113, Claim 16 and related claims 59 and 114, Claim 17 and related claims 61 and 115 and Claim 18 and related claims 62 and 116 the recitations, “wherein the rights specification is created based upon a user profile”, “wherein the rights specification is created based upon a default rights specification”, “wherein the rights specification is created based upon inference rules”, and “wherein the step of creating the rights specification is based upon an analysis of the selected content”, such recitations are given little patentable weight because these

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phrases impart no structural or functional specificity which serves to patentably distinguish the instant invention from the other "creating" already disclosed by Spagna.

Regarding claim 19 and related claims 117 and 120, Spagna teaches a method, further comprising creating a publishing profile (Col 9, lines 52 – 57, Col 12, lines 23 – 67, Col 13, lines 1 – 67 and Col 14, lines 1 – 34).

Regarding claim 20 and related claims 69 and 118, Spagna teaches a method, wherein the publishing profile includes at least one publisher identifier and information relating to a pre-existing agreement between at least one of a publisher, a distributor and a registrar (Col 12, lines 53 – 56 and Figures 9 and 10).

Regarding claim 21 and related 70 and 119, Claim 22 and related claims 71 and 121, Claim 23 and related claims 72, 73, 74 and 122, Claim 24 and related claims 75 and 123, and Claim 25 and related claim 76, the recitations "wherein the publishing profile includes information regarding at least one of a distributor and facilitator through which a certain type of content may be at least one of distributed, archived and registered", "wherein the publishing profile is created based upon a user profile", "wherein the publishing profile is created based upon a default publishing profile", "wherein the publishing profile is created based upon at least one inference rule" and "wherein the publishing profile is created based upon an analysis of the selected content", such recitations are given little patentable weight because these phrases impart no structural

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or functional specificity which serves to patentably distinguish the instant invention from the other "information including and creating" already disclosed by Spagna.

Regarding claim 26 and related claim 125, Spagna teaches a method, further comprising confirming the request to publish (Col 14, lines 1 – 15).

Regarding claim 27, Spagna teaches a method, wherein the user is a publisher (Col 15, lines 16 – 19).

Regarding claim 28 and related claim 126, Spagna teaches a method, wherein the step of generating comprises sending a publication notice to at least one distributor (Col 21, lines 16 – 18).

Regarding claim 29 and related claim 127, the recitation, "wherein the step of generating further comprises receiving a response from the at least one distributor computer system", such recitation is given little patentable weight because it imparts no structural or functional specificity which serves to patentably distinguish the instant invention from the other "supplying" already disclosed by Spagna.

Regarding claim 30 and related claim 128, Spagna teaches a method, further comprising packaging the content for the distributor computer system if the response

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from the at least one distributor computer system indicates that the distributor computer system wants to distribute the content (Col 21, lines 19 – 24).

Regarding claim 31, Spagna teaches a method, wherein the user is the distributor computer system (Col 15, lines 16 – 19).

Regarding claim 32, Spagna teaches a method, wherein the user is a content creator (Col 15, lines 16 – 19).

Regarding claim 33 and related claims 86 and 129, Spagna teaches a method, further comprising packaging the content (Col 21, lines 1 – 6).

Regarding claim 34 and related claims 87 and 130, Spagna teaches a method, wherein the step of packaging comprises sending the content to a distributor computer system (Col 21, lines 19 – 21).

Regarding claim 35 and related claim 131 as well as Claims 41, 48, 55, 63, 66, 68, 77, 79, 80, 82, 95, 98, and 137, Spagna teaches a method and system including “storing” (see at least Col 12, lines 46 – 48 and Figure 9 and Figure 12). Please note for these claims that in online methods and systems for publishing content that include the word “storing” adding such specifics as “at least one user profile” is given little patentable weight. The phrase(s) and or word(s) after ‘storing’ are given little patentable weight

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because the claim language limitations are considered to be non-functional descriptive material, which does not patentably distinguish the applicant's invention from Spagna. Thereby, the non-fictional descriptive material is directed only to the content of the stored data and does not affect either the structure or method/process of Spagna, which leaves the method and system unchanged.

Regarding claim 36 and related 88 and 132, Spagna teaches a method, wherein the step of packaging comprises encrypting the content (Col 21, lines 1 – 3).

Regarding claim 37 and related claims 81 and 136, Spagna teaches a method, wherein the step of packaging comprises sending the content to a content repository (Col 21, lines 7 – 8).

Regarding claim 38 and related claims 89 and 134, Spagna teaches a method, further comprising registering the content (Col 45, lines 38 – 65).

Regarding claim 39 and related claims 90 and 135, Spagna teaches a method, wherein the step of registering comprises forwarding at least one of metadata, a record of published content, a content identifier, the rights specification and marketing information to a registrar (Col 45, lines 38 – 65).

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Regarding claim 40, Spagna teaches a method, further comprising registering the transaction of generating (Col 45, lines 66 – 67 and Col 46, lines 1 – 5).

Regarding claim 42 and related claims 84, 85 and 138, Spagna teaches a method, wherein the step of generating comprises: preparing a notice that includes the metadata and rights specification; and sending the notice to the distributor computer system (Col 71, lines 31 – 34).

Regarding claim 43 and related claim 139, Spagna teaches a method, further comprising using at least one distributor business rule to determine whether the distributor computer system wants to distribute the selected content and wherein the generating is based upon the determination (Col 45, lines 32 – 42).

Regarding claim 44 and related claim 140, Spagna teaches a method, further comprising receiving a response from the distributor computer system and wherein the generating is based upon the response (Col 45, lines 32 – 42).

Regarding 45 and related claim 141, Spagna teaches a method, further comprising updating a distributor computer system catalog based upon the metadata and rights specification (Col 46, lines 1 – 3 and Col 82, line 33).

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Regarding claim 46 and related claims 92, 94, 96 and 142, Ginter teaches a method, further comprising modifying one of the metadata and rights specification based upon a distributor business rule (see at least Col 2, lines 46 – 53).

Regarding claim 58, Spagna teaches a method, further comprising creating the rights specification (Col 1, lines 54 – 56, Col 8, line 14 and Col 10, lines 15 – 24).

Regarding claim 78, Spagna teaches a system, wherein the processor is further responsive to user input to create the content (Col 12, lines 34 – 36).

Regarding claim 83, Spagna teaches, wherein the processor is further responsive to request to generate a confirmation request and to receive a confirmation before generating the metadata and rights specification (Col 22, lines 61 – 65 and Col 26, lines 10 – 19).

Regarding claim 91, Spagna teaches a system, further comprising: a distributor system in selective communication with the publishing system, wherein the distributor system comprises: a catalog database for storing metadata and rights specifications associated with at least one content; an interface for selective communication with a publishing system; and a distributor processor in communication with the interface and the catalog database, wherein the processor is responsive to the generated metadata and rights specification to determine whether to store the generated metadata and rights

specification in the catalog database (see at least Col 9, lines 52 – 56, Col 73, lines 47 – 56 and Figure 15B).

Regarding claim 97, Spagna teaches a system, further comprising: a consumer interface in communication with the processor; and a consumer database in communication with the processor, wherein the consumer database stores at least one consumer profile (Col 9, lines 57 – 60).

Regarding claim 124, Spagna teaches a media, further comprising: information that analyzes the selected content; and information that creates a publishing profile based upon the results of the analysis (Col 55, lines 46 – 50).

Regarding claim 133, Spagna teaches, wherein the information that packages the consent comprises information that sends the content to a consent repository (Figure 6).

Regarding claim 145 (New), Spagna teaches a method, wherein the rights specification includes information regarding the specific rights granted to the content if a given set of conditions is satisfied (Col 22, lines 49 – 67).

Regarding claim 146 (New), Spagna teaches a method, wherein said step of automatically generating and item comprises perform a sequence of actions specified by the publishing profile (Col 13, lines 56 – 67).

Response to Arguments

Applicant's arguments filed 6-24-04 have been fully considered but they are not persuasive.

The applicant argues that Spagna does not suggest or teach regarding receipt of a user profile and generating of metadata and rights specification based on a user profile.

Although Spagna did not specifically disclose a user profile, Spagna did disclose and suggest to one of ordinary skill that generating of metadata was based on rights specification for specific users (Col 26, lines 10 – 67). On the other hand, Ginter did disclose an account profile, which as defined by the reference (Col 286, line 14) meets the examples provided in the applicant's specification. In that regard, the combination of these references would have taught on of ordinary skill that a receipt of a user profile generates appropriate metadata with associated rights specification. Moreover, user profiles in on line methods and systems were old and well known at the time of the applicant's invention.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Rob Rhode** whose telephone number is **(703) 305-8230**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeff Smith** can be reached on **(703) 308-3588**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

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(703) 872-9306

[Official communications; including

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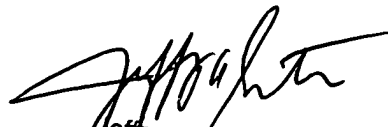
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(703) 746-7418 [Informal/Draft communications, labeled

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Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RER



Jeffrey A. Smith
Primary Examiner